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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/714,838

11/18/2003

Sho Miyazaki

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EXAMINER

LEE, JINHEE J

ART UNIT

PAPER NUMBER

2831

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,838

Applicant(s)

MIYAZAKI, SHO

Examiner

Jinhee J. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 4-5, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima et al. (JP02002324627A) in view of Inaba et al. (US005304067A).

Re claim 1, Fukushima et al. substantially discloses a shielded wire harness comprising: a plurality of wires (10); a plurality of wire-side terminals (13) respectively connected to the plurality of wires and configured to be connected to respective terminals disposed within a shield case (B) of an equipment; a shielding member (14, conductive braid) configured to enclose the plurality of wires collectively; a protecting member (15, corrugated tube) configured to enclose the shielding member; and a shield shell (25, including 25a flange portion) configured to be connected to the shield case, wherein the shielding member comprises a diameter-spread portion (unnumbered on 14) in which a diameter thereof is spread larger than that of the protecting member at an end portion where the shielding member is projected from the protecting member, and connected to the shield shell at an end edge thereof, wherein the shielded wire harness further comprises a covering member (27, protector) formed in a tube shape and

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configured to cover the diameter-spread portion (see figure 2), wherein the shielding member is made of braided wires formed by metal thin lines braided in a meshed manner (conductive braid 14, see figures 2 and 3). Fukushima et al. does not explicitly disclose that the covering member is made of elastic material. However, Inaba et al. teaches of a covering member (27 and 28, rear covers) made of elastic material (made of insulating synthetic resin and rubber, see figure 2 and column 3 lines 6-7 according to the numbering in the middle). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the elastic material covering member of Inaba et al. on the device of Fukushima et al. in order to provide protection of the device.

Re claim 2, note that Fukushima et al. discloses a shielded wire harness wherein, the shielding member is formed in a tube shape (see figure 2).

Re claim 4, note that Fukushima et al. discloses a shielded wire harness wherein, the protecting member has a flexible characteristic (corrugated tube 15, see figure 2).

Re claim 5, note that Fukushima et al. discloses a shielded wire harness wherein, the protecting member is made of corrugated tube (see figure 2).

Re claim 7, Note that Inaba et al. teaches of a covering member (27 and 28, rear covers) made of rubber (see figure 2 and column 3 lines 6-7 according to the numbering in the middle).

Re claim 9, note that Fukushima et al. discloses a shielded wire harness wherein, the covering member comprises an engaging portion (27c, flange portion)

configured to engage with at least one of the protecting member and the shield shell (see figures 1 and 2).

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima et al. in view of Inaba et al., as applied to claim 1 above, and further in view of Chen et al. (US006609934B2).

Re claim 8, Fukushima et al. modified as taught by Inaba et al. substantially discloses a shielded wire harness as set forth in claim 1 wherein the covering member comprises: a large-diameter portion (unnumbered on 27 near 27c) corresponding to the shield shell; a small-diameter portion (27a, narrowed end portion) corresponding to the protecting member (see Fukushima et al.). Fukushima et al./Inaba et al. does not explicitly disclose a slit formed on the covering member from the opening end of the small-diameter portion. However, Chen et al. teaches of a covering member (40, shield shell) with a slit (unnumbered between tentacles 404) formed on the covering member from the opening end of the small-diameter portion (unnumbered at the opening end of the end portion of the tentacles, see figure 6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the slit on the covering member of Chen et al. on the device of Fukushima et al. in order to embrace the periphery of the cable.

Response to Arguments

4. Applicant's arguments filed 1/10/05, with respect to the rejection(s) of claim(s) 1-9 regarding motivational statement used for 103 rejection of claims 6 and 7 have been

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fully considered and are persuasive. Therefore, the rejection has been modified with a better defining motivational statement.

In response to applicant's arguments that "in order to provide interconnection between housings and cables" is without merit has been fully considered and examiner makes the current rejection a non-final rejection.

5. Applicant's arguments filed 1/10/05 have been fully considered but they are not persuasive regarding matters other than stated in the preceding two paragraphs.

In response to applicant's arguments that prior art "would not benefit from the use of an elastic material", examiner points out that using elastic material as the covering member (27, protector) on Fukushima et al. would be merely a substitution of a suitable known material for the same use. Elastic material is capable of being "bolted" and "sandwiched". Note that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Also note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinhee J. Lee whose telephone number is 571-272-1977. The examiner can normally be reached on M, T, Th and F at 6:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A. Reichard can be reached on 571-272-2800 ext. 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jinhee J Lee
Patent Examiner
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A handwritten signature in black ink, appearing to read 'Jinhee J. Lee', with a long horizontal flourish extending to the right.

jjl